REMARKS

I. Status of the Claims

Claims 80-83, 86-93, 97-100 and 104-186 are pending in this application. Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 stand rejected. Claims 81, 83 and 150-166 are withdrawn from consideration. No claim has been amended herein.

Applicants respectfully thank the Examiner for withdrawing the rejection under 35 U.S.C. § 112, and for withdrawing the rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 5,843,417 ("Hanna") in view of U.S. Patent No. 4,552,753 ("Elm"). Applicants submit that all of the pending claims are allowable for at least the reasons of record, which are specifically incorporated herein by reference, as well as the following additional reasons.

II. Rejections under 35 U.S.C. § 103(a)

Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 are rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna") in view of U.S. Patent No. 5,196,187 to Nicoll et al. ("Nicoll"). *Office Action* at pp. 4-6. The Examiner states that Hanna discloses a water-in-oil emulsion comprising a water phase and an oil phase, and further comprises a particle, surfactant, polymer, and other ingredients that are common to cosmetic compositions. *Id.* at p. 5. However, the Examiner states that "Hanna et al. do not teach the specific volatile silicone oils as claimed by applicant." *Id.* Furthermore, in the Office Action dated August 22, 2008, the Examiner states that "Hanna et al. do not teach the claimed concentration of the ingredients" or "the viscosity of the composition." In view of these deficiencies, the Examiner relies upon the teachings of Nicoll for its disclosure of "a 5 to 20% volatile

polydimethylsiloxane such as Dow Corning 345 fluid" in a "cosmetic composition suitable for topical application." *Id.*

The Examiner contends that "[i]t would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Hanna et al. with Nicoll et al" and "[o]ne would have expected success since Hanna et al. and Nicoll et al. teach oil-in-water cosmetic compositions for topical application." *Id.* at p. 6. Applicants respectfully disagree.

The standards for an obviousness analysis have been delineated in Graham v. John Deere, 383 U.S. 1, 148 U.S.P.Q. 459 (1996). The four factual inquires enunciated therein as a background for determining obviousness are as follows:

(A) Determining the scope and content of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations.

See M.P.E.P. § 2141(II).

Upon resolving these four inquiries, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Indeed, the Supreme Court mandates that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *KSR Int'l Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")); *see* also M.P.E.P. § 2141(III).

The combination of references relied upon by the Examiner fail to meet these standards. Hanna does not teach or suggest all of the present claim limitations. For example, Hanna's composition does not contain a disclosure of a fluid foundation composition comprising the combination of at least one volatile hydrocarbon-based oil; at least one first volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C; and at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C.

Hanna states, at col. 3, lines 33-36, that the "present invention oil may contain, in addition to the hydrocarbon oils, other oils... such as silicone oils, including volatile silicone oils." Hanna states just a few lines later that the "absence of silicone oils such as volatile silicone oils in the invention oil is another preferred embodiment." *Id.* at col. 3, lines 43-44. Applicants submit that the Examiner has not provided any reason/evidence explaining why one of ordinary skill in the art, in reading Hanna, would be motivated to incorporate any volatile silicone oils to arrive at the claimed composition with any reasonable expectation of success.

Hanna does not disclose or suggest combining at least one volatile hydrocarbon-based oil with at least two different volatile silicone oils having distinct flash points. At best, Hanna mentions that "[t]he present invention oil may contain. . .other oils commonly used in W/O cosmetic emulsions such as silicone oils...." *Id.* at col. 3, lines 33-36. However, there is no guidance in Hanna to specifically choose at least two

volatile silicone oils, let alone the combination of at least one volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C, and at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C. Among its many failings, Hanna provides absolutely no reason to the skilled artisan to select a volatile silicone oil, much less at least two volatile silicone oils having distinct ranges of flash point to arrive at the present invention. There is simply no guidance in Hanna to use these at least two volatile silicone oils containing the claimed flashpoints.

Nicoll fails to cure these deficiencies. Nicoll teaches a **single** volatile polydimethylsiloxane for use in a water-in-silicone oil emulsion. *Nicoll* at col. 3, lines 39-45 and col. 4, lines 29-42. Specifically, the Examiner relies on the recitation of Dow Corning 345 fluid as the volatile silicone oil utilized in Nicoll's composition. *Office Action* at p. 5. According to the Material Safety Data Sheet ("MSDS") for Dow Corning 345 fluid provided herewith, this volatile polydimethylsiloxane has a flash point of 77 °C. Thus, Dow Corning 345 does not meet the requirements of the at least one second volatile silicone oil as claimed. Accordingly, the Examiner's reference to Dow Corning 345 fluid does not provide one of ordinary skill in the art any reason/motivation to use a volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C.

Among the other polydimethylsiloxanes described by Nicoll, such as, for example, Dow Corning 344 fluid and Dow Corning 200 fluid, the MSDS sheets indicate flash points of 57.8 °C and greater than 120 °C, respectively. Similar to Dow Corning 345 fluid, neither Dow Corning 344 nor Dow Corning 200 represent a volatile silicone oil

with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C. Therefore, Nicoll lacks the teaching of a second volatile silicone oil as recited in the present claims.

In addition, Nicoll is also silent with respect to the use of any volatile hydrocarbon-based oils. Nicoll provides no teaching regarding the use of a volatile hydrocarbon-based oil in combination with at least **two** volatile silicone oils would be advantageous to obtaining a fluid foundation composition. There is nothing in Nicoll that would point to or motivate the skilled artisan to incorporate a volatile hydrocarbon-based oil in conjunction with at least two volatile silicone oils, and combine this with Hanna, which is notably absent of volatile silicone oils having distinct flash points, and recognize that such a combination would afford predictable results.

For at least the aforementioned reasons, there is no finding that would provide the skilled artisan with any reason to combine the elements of Hanna and Nicoll as suggested by the Examiner and further recognize that the combination of these elements would have been predictable. Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness, and request that this rejection be withdrawn.

III. Double Patenting Rejection

Claims 80, 82, 84-149 and 167-186 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of copending U.S. Application No. 10/603,698 ("the '698 application") for the reasons set forth at pages 3-4 of the Office Action. Since the '698 application was filed prior to the present application, Applicants respectfully request that

the Examiner hold this rejection in abeyance until there is an indication of allowable subject matter in either this application or the '698 application. At that time, it would be possible to determine in which of these two applications, if any, a Terminal Disclaimer would need to be filed. *See* M.P.E.P. § 804 (I)(B)(1).

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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